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09/991,746	11/26/2001	Frederic Bordeaux	3633-509	9894

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EXAMINER

GROUP, KARL E

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 17

Application Number: 09/991,746

Filing Date: November 26, 2001

Appellant(s): BORDEAUX ET AL.

Seth Watkins
For Appellant

EXAMINER'S ANSWER

MAILED
DEC 15 2003
GROUP 1700

This is in response to the appeal brief filed 10-27-03.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection
----- contained in the brief is correct.-----

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

Appellant's brief includes a statement that claims 1-6 and 9-15 stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

(8) *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) *Prior Art of Record*

5,858,897

Maeda et al

1-1999

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-6,14,15 are rejected under 35 U.S.C. 102(a or e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Maeda et al.

Maeda et al teach a glass composition to be used as a substrate (sheet). The glass composition has a thermal expansion coefficient in the examples ranging up to 91×10^{-7} at a temperature range of 50 to 350 °C. Claims 1-6 merely require a silica-soda glass which the glass of Maeda et al includes Na₂O and SiO₂. Claim 14 requires Na₂O>18, K₂O>5 and Al₂O₃<3 for the relationship to apply. Example 8 is outside all these conditions, therefor the relationship does not apply. The CaO content is 10.4 in example 8 meeting the limitation of claim 15. It is well settled that when a claimed composition appears to be substantially the same as a composition disclosed in the prior art, the burden is properly upon the applicant to prove by way of tangible evidence that the prior art composition does not necessarily possess characteristics attributed to the CLAIMED composition. In re Spada, 911 F.2d 705, 15 USPQ2d 1655 (Fed. Circ. 1990); In re Fitzgerald, 619 F.2d 67, 205 USPQ 594 (CCPA 1980); In re Swinehart, 439 F.2d 2109, 169 USPQ 226 (CCPA 1971). Furthermore because example 8 falls within the ranges set forth in the claims, products having identical compositions may not have mutually exclusive properties.

Claims 1-6,9-14 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Morimoto et al.

Morimoto et al teach a glass composition having a high young's modulus and thermal expansion as well as low heat conductivity, column 2, lines 39-43. Example 2, column 9 falls squarely within the compositions of claims 12 and 14 with a total of 17.1 K₂O and Na₂O. Claims 1-6 fail to set forth any composition that distinguishes from the examples of Morimoto et al. It is well settled that when a claimed composition appears to be substantially the same as a composition disclosed in the prior art, the burden is properly upon the applicant to prove by way of tangible evidence that the prior art composition does not necessarily possess characteristics attributed to the CLAIMED composition. In re Spada, 911 F.2d 705, 15 USPQ2d 1655 (Fed. Circ. 1990); In re Fitzgerald, 619 F.2d 67, 205 USPQ 594 (CCPA 1980); In re Swinehart, 439 F.2d 2109, 169 USPQ 226 (CCPA 1971).

(11)Response to Argument

Appellants argue that Maeda et al teach a thermal expansion coefficient of 83×10^{-7} which is outside the claimed range of 100×10^{-7} . This is not persuasive in overcoming the rejection because the thermal expansion coefficients taught by Maeda et al are taken at temperatures between 50 to 350° C (column 6, lines 14-15). The instant claims and disclosure fail to disclose what temperatures the thermal expansions are taken so they cannot be directly compared to the values of Maeda et al. Thermal expansion is dependent upon the temperature at which it is taken. It is further argued that Maeda et al fail to disclose the Young's Modulus and thermal conductivity. It is

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agreed that Maeda et al fail to disclose these properties however appellants have not shown by way of tangible evidence that the glasses of Maeda et al do not inherently possess properties outside the claimed ranges. Claims 1-6 require only silica and sodium oxide which are components of the Maeda et al glass.

It is also argued that Morimoto et al fail to disclose the thermal expansions, young modulus and thermal conductivity of the taught glass compositions. Morimoto et al do teach high young's modulus, and thermal expansion in combination with low heat conductivity. Applicants have not shown by way of tangible evidence that the values of the instantly claimed glasses are outside that taught by Morimoto et al. It is well settled that when a claimed composition appears to be substantially the same as a composition disclosed in the prior art, the burden is properly upon the applicant to prove by way of tangible evidence that the prior art composition does not necessarily possess characteristics attributed to the CLAIMED composition. In re Spada, 911 F.2d 705, 15 USPQ2d 1655 (Fed. Circ. 1990); In re Fitzgerald, 619 F.2d 67, 205 USPQ 594 (CCPA 1980); In re Swinehart, 439 F.2d 2109, 169 USPQ 226 (CCPA 1971). For the above reasons, it is believed that the rejections should be sustained.

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Respectfully submitted,


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Art Unit 1755

keg
December 9, 2003

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